

REMARKS

Claims 1-21 are all the claims presently pending in the application. Claims 1 and 18 have been amended.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1, 2, 4, 5, 7 and 8 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Bernstein et al. (U. S. Patent No. 6,970,189). Claim 9 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bernstein.

Claims 3, 6 and 19 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bernstein in view of Ito et al. (U. S. Patent No. 6,967,675). Claims 10, 11 and 21 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bernstein in view of Yoshida et al. (U. S. Patent No. 6,307,591).

Claims 12, 14-18 and 20 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bernstein in view of Mattes (U. S. Patent No. 6,038,295). Claim 13 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bernstein in view of Mattes and Ito.

These rejections are respectfully traversed in view of the following discussion.

I. THE CLAIMED INVENTION

An exemplary aspect of the claimed invention (e.g., as recited in **claim 1**) is directed a portable device which includes a recording device which records, in a recording medium, an image to be transmitted to a server via a communication device, the server providing image service. The portable device also includes a service information input device which inputs, from the communication device, service information about the image service provided by the server,

Importantly, the recording device records the image based on the inputted service information (i.e., service information about the image service provided by the server) in the recording medium (Application Figure 6; page 12, line 21-page 7, line 6).

Conventionally, uploading an image from a camera to a service server (e.g., printing or distribution of the image) via a mobile phone, takes a long time and since the communication speed between the camera and the phone is typically different from the transferring speed between the phone and the service server, management of communication is complicated (Application at page 2, line 20-page 3, line 7).

In an exemplary aspect of the claimed invention, on the other hand, a portable device includes a recording device which records the image based on the inputted service information in the recording medium (Application Figure 6; page 12, line 21-page 7, line 6). This may help to allow the portable device to readily record an image which is automatically changed in size or compressibility according to obtained service information, at high speed, and helps to allow the mobile phone to readily transmit an image meeting a request of the server at high speed (Application at page 17, lines 4-30).

II. THE ALLEGED PRIOR ART REFERENCES

A. Bernstein

The Examiner alleges that Bernstein teaches the claimed invention of claims 1, 2, 4, 5, 7 and 8, and makes obvious the invention of claim 9. Applicant submits however, that there are features of the claimed invention that are not taught or suggested by Bernstein.

Bernstein discloses a system for automatically configuring a hand-held camera. The system includes a camera 22, and a photo op transceiver 20 which pushes N camera setting parameters to automatically configure the camera 22 for capturing a photo of a subject 34 (Bernstein at col. 5, lines 42-52).

However, Bernstein does not teach or suggest a portable device including a recording device which "*records the image based on the inputted service information in the recording medium*", as recited, for example, in claim 1. As noted above, this may help to allow the portable

device to readily record an image which is automatically changed in size or compressibility according to obtained service information, at high speed.

Clearly, this feature is not taught or suggested by Bernstein. Indeed, the Examiner attempts to rely on col. 5 at lines 42-52 to support his position. However, nowhere in this passage or anywhere else does Bernstein teach or suggest a portable device including a recording device which records the image based on the inputted service information in the recording medium.

Presumably, the Examiner attempts to equate the camera 22 in Bernstein with the portable device of the claimed invention. However, the camera 22 receives parameters for CAPTURING a photo of a subject. These parameters include shutter speed, focal distance, etc. (e.g., see Table I at col. 5, lines 12-20). That is, the camera 22 CAPTURES an image based on camera setting parameters.

However, this is completely unrelated to the claimed invention in which the portable device may RECORD an image based on inputted service information. Applicant respectfully submits that capturing an image and recording an image may be considered to be completely different. Thus, it is completely unreasonable for the Examiner to attempt to equate the camera 22 in Bernstein with the portable device of the claimed invention.

Moreover, even assuming (arguendo) that the camera 22 in Bernstein records an image based on inputted information from the server 12, the information is not service information **about the image service provided by the server** as in the claimed invention. Indeed, the server 12 in Bernstein is simply use to transmit camera setting parameters to photo op sites (e.g., museums, national parks, etc.) to manage photo op transceivers at the photo op sites (Bernstein at col. 11, lines 26-29). Nowhere does Bernstein teach or suggest that the server 12 provides an image service (e.g., image printing service or image distribution service) as in the claimed invention.

Certainly, the camera setting parameters transmitted by the server 12 cannot reasonably be considered to be service information **about the image service provided by the server.** **Indeed, the camera setting parameters pertain only to the camera 22 and have nothing to**

do with the server and certainly have nothing to do with any "service" provided by the server. Thus, it is completely unreasonable to attempt to equate the camera setting parameters in Bernstein with the "service information" of the claimed invention.

Further, with respect to claim 9, Applicant respectfully submits that the alleged facts of which the Examiner attempts to take Official Notice are not capable of instant and unquestionable demonstration as being well-known, and therefore, it is not appropriate for the Examiner to attempt to take "Official Notice" of these alleged facts (e.g., see MPEP §2144.03). Further, the Examiner must provide Applicant with the explicit basis on which the Examiner regards the matter as subject to Official Notice. Moreover, Applicant would point out to the Examiner that in response to Applicant's traversal of the Examiner's assertion of such "Official Notice", **the Examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.**

Therefore, Applicant submits that Bernstein does not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

B. Ito, Yoshida and Mattes

The Examiner alleges that Bernstein would have been combined with Ito to form the invention of claims 3, 6 and 19, and with Yoshida to form the invention of claims 10, 11 and 21, with Mattes to form the invention of claims 12, 14-18 and 20, and with Mattes and Ito to form the invention of claim 13. Applicant submits however, that these alleged references would not have been combined and even if combined, the combination would not teach or suggest each and every feature of the claimed invention.

Indeed, Applicant submits that these references are unrelated, and no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

In fact, Applicant submits that the references provide no motivation or suggestion to urge

the combination as alleged by the Examiner. Indeed, these references clearly do not teach or suggest their combination. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, neither Bernstein, nor Ito, nor Yoshida, nor Mattes, nor any alleged combination thereof teaches or suggests a portable device including a recording device which *"records the image based on the inputted service information in the recording medium"*, as recited, for example, in claim 1. As noted above, this may help to allow the portable device to readily record an image which is automatically changed in size or compressibility according to obtained service information, at high speed.

Clearly, this feature is not taught or suggested by Ito. Indeed, the Examiner attempts to rely on col. 7, lines 52-61 and Figure 3 in Ito to support his position. However, nowhere in this passage or anywhere else does Ito teach or suggest a portable device including a recording device which records the image based on the inputted service information in the recording medium.

In fact, Ito simply teaches a camera that may be used to transmit an image file recorded on a memory card to be transmitted to a server via a communication circuit (Ito at Abstract; Figure 1; col. 6, lines 1-23). Ito teaches that a URL of the server is transmitted to an Internet service provider allowing the camera to access the server (Ito at col. 7, lines 60-61). Nowhere does Ito teach or suggest that the camera records images based on service information from the server. Therefore, Ito clearly does not make up for the deficiencies of the other cited references.

Likewise, this feature is not taught or suggested by Yoshida. Indeed, the Examiner attempts to rely on col. 7, lines 1-6 in Yoshida to support his position. However, nowhere in this passage or anywhere else does Yoshida teach or suggest a portable device including a recording device which records the image based on the inputted service information in the recording medium.

In fact, Yoshida simply teaches a camera unit 3 that stores an object image in RAM 13, and storing an aspect ratio recognition signal for use in recognizing the aspect ratio as a code number together with the image signal (Yoshida at col. 7, lines 7-12). Nowhere does Yoshida

teach or suggest a server, let alone that the camera unit 3 records images based on service information from a server. Therefore, Yoshida clearly does not make up for the deficiencies of the other cited references.

Likewise, this feature is not taught or suggested by Mattes. Indeed, the Examiner attempts to rely on col. 8, lines 36-45 in Mattes to support his position. However, nowhere in this passage or anywhere else does Mattes teach or suggest a portable device including a recording device which records the image based on the inputted service information in the recording medium.

Indeed, Mattes is directed to a method of allegedly archiving digital images simply, fast and in such a way that the information therefor may be easily tracked. Mattes has nothing to do with a portable device which records, in a recording medium, an image to be transmitted to a server via a communication device. Thus, Mattes teach or suggest a portable device including a recording device which records the image based on the inputted service information in the recording medium. Therefore, Mattes clearly does not make up for the deficiencies of the other cited references.

Therefore, Applicant submits that these alleged references would not have been combined and even if combined, the combination would not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-21, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

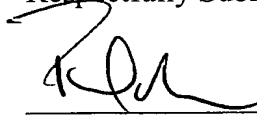
Serial No. 10/057,919
Docket No. FJ-2001-039-US
MAS.011

14

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 5/5/07



Phillip E. Miller, Esq.
Registration No. 46,060

McGinn IP Law Group, PLLC
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254